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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,079	09/11/2000	Brian M. Romansky	E-996	4596

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EXAMINER

ELISCA, PIERRE E

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 03/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/658,079

Applicant(s)

ROMANSKY, BRIAN M.

Examiner

Pierre E. Elisca

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 11-19, 21-28, 30-34 and 36-40 is/are rejected.
- 7) ☒ Claim(s) 3, 6-10, 20, 29, 35 and 41 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

1. This Office action is in response to Applicant's amendment, filed on 12/13/2003.
2. Claims 1-41 are pending.

### ***Claim Objections***

3. Claims 3, 6-10, 20, 29, 35 and 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 4, 5, 11-19, 21-28, 30-34 and 36-40 are rejected under 35 U.S.C. 102 (b) as being anticipated by Liechti et al. (5,715,164).

**As per claims 1, 4, 5, 12-14, 17, and 24-26** Liechti discloses a communications system/method that has a host computer in a data center communicates with a multiplicity of electronic postage meters via telephone dial-up lines to conduct telemeter

Art Unit: 3621

setting transactions (which is equivalent to Applicant's claimed invention wherein it is stated that a method of metering digital content having a message to be presented to a plurality of users of a communications network), comprising:

embedding a code in said message (see., abstract, col 1, lines 20-31, specifically wherein it is stated that verifying the meter's identity and ascertains the availability of funds in the user's account and supplies a combination code to the meter or to the user, col 2, lines 1-7);

detecting the embedded code (see., abstract, col 1, lines 20-31); and

based on the detected embedded code, counting the number of times the message is presented to a user of the communications network (see., abstract, col 1, lines 20-31, specifically wherein it is stated that verifying the meter's identity and ascertains the availability of funds in the user's account and supplies a combination code to the meter or to the user, and col 2, lines 35-45, specifically wherein it is stated that the host computer may collect statistical data from each meter, and may impose a cumulative postage amount limit, a time limit and/or a piece limit on the meter, please note that collecting statistical data also includes counting the number of times the message is presented and so on, col 5, lines 23-65).

**As per claims 2, 16, and 19 Liechti** discloses the claimed method, wherein the communications network includes the internet (see., col 3, lines 47-56, specifically wherein it is stated that host computer in data center is capable of communicating with the meters via telephone dial up lines, and therefore, it is inherent to realize that host

Art Unit: 3621

computer is also capable of connecting with the meters via Internet since Fig 1 of Liechti discloses a plurality of modems).

**As per claims 11, 15, 18, 21, and 23, Liechti** discloses the claimed method wherein the digital content is indicative of an advertisement (see., col 10, lines 1-5, specifically wherein it is stated that computer 103 may utilize the hardware information for advertisement).

**As per claims 22, 27, and 30-34, 36-40 Liechti discloses** a communications system/method that has a host computer in a data center communicates with a multiplicity of electronic postage meters via telephone dial-up lines to conduct telemeter setting transactions (which is equivalent to Applicant's claimed invention wherein it is stated that a method of metering digital content having being presented to users of a communication network, the digital content being contained in a network data stream and including a message embedded with a code to allow a number times the message is presented to a user to be counted see., abstract, col 1, lines 20-31, specifically wherein it is stated that verifying the meter's identity and ascertains the availability of funds in the user's account and supplies a combination code to the meter or to the user, and col 2, lines 35-45, specifically wherein it is stated that the host computer may collect statistical data from each meter, and may impose a cumulative postage amount limit, a time limit and/or a piece limit on the meter, please note that collecting statistical data

Art Unit: 3621

also includes counting the number of times the message is presented and so on, col 5, lines 23-65, comprising:

monitoring the network data stream to detect data representative of the embedded code (see., abstract, col 1, lines 20-31, specifically wherein it is stated that verifying the meter's identity and ascertains the availability of funds in the user's account and supplies a combination code to the meter or to the user, col 2, lines 1-7);

recording a number of times the data representative of the embedded code is detected,

the number of times the data representative of the embedded code is detected being

indicative of presentation of the message to a user (see., abstract, col 1, lines 20-31, specifically wherein it is stated that verifying the meter's identity and ascertains the availability of funds in the user's account and supplies a combination code to the meter or to the user, and col 2, lines 35-45, specifically wherein it is stated that the host computer may collect statistical data from each meter, and may impose a cumulative postage amount limit, a time limit and/or a piece limit on the meter, please note that collecting statistical data also includes counting the number of times the message is presented and so on, col 5, lines 23-65); and

calculating a charge (or charge class) for presenting the message based on the

computer of times the data representative of the embedded code is detected (see.,

abstract, col 1, lines 20-31, col 2, lines 14-27, col 4, lines 50-60, specifically wherein it is stated that charge class 1 includes items with a postage value of 29 cents, charge class 2 includes items with postage values between 30 cents and 35 cents, please note that

Art Unit: 3621

charge classes i.e class 1 and class 2 are interpreted as a process of calculating a charge).

**As per claim 28, Liechti** discloses the claimed method, wherein the communications network includes the internet (see., col 3, lines 47-56, specifically wherein it is stated that host computer in data center is capable of communicating with the meters via telephone dial up lines, and therefore, it is inherent to realize that host computer is also capable of connecting with the meters via Internet since Fig 1 of Liechti discloses a plurality of modems).

## **RESPONSE TO ARGUMENTS**

6. Applicant's arguments filed on 12/13/2003 have been fully considered but they are not persuasive.

## **REMARKS**

7. In response to Applicant arguments, Applicant argues that the prior art of record (Liechti) taken alone or in combination fails to disclose:

a. "there is no disclosure, teaching or suggestion of embedding any type of code in a message". However, the Examiner respectfully disagrees since Liechti discloses a postage metering machine that is provided with a comparator for comparing two key code words, please note that each two key words is embedded in a message see., abstract, col 2, lines 36-48, col 3, lines 3-28, col 4, lines 38-55.

Art Unit: 3621

b. " counting the number of times the message is presented to one of the users". Based upon foregoing rejection detailed above, it is believed that Liechti discloses this limitation in the abstract, col 1, lines 20-31, specifically wherein it is stated that verifying the meter's identity and ascertains the availability of funds in the user's account and supplies a combination code to the meter or to the user, and col 2, lines 35-45, specifically wherein it is stated that the host computer may collect statistical data from each meter, and may impose a cumulative postage amount limit, a time limit and/or a piece limit on the meter, please note that collecting statistical data also includes counting the number of times the message is presented and so on, col 5, lines 23-65, col 3, lines 29-35).

### ***Conclusion***

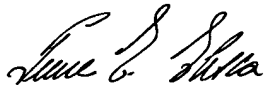
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Art Unit: 3621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Pierre Eddy Elisca

Primary Patent examiner

February 27, 2004